

## REMARKS

This Amendment is in response to the Office Action mailed September 28, 2000. In the Final Office Action, the Examiner objected to claim 43 and rejected (i) claims 1-14 and 16-45 under 35 U.S.C. §112, first and second paragraphs, (ii) claims 14, 16-20, 23, 27, 32, 40, 42 and 45 under 35 U.S.C. §101 and (iii) claims 1-14, 16-21, 27-30 and 36-45 under 35 U.S.C. §103(a). Applicants have amended claims 1, 5, 7, 14, 39-40, and 43. Reconsideration in light of the amendment and remarks made herein is respectfully requested.

### I. SPECIFICATION

In response to the Examiner statement (Office Action, pages 2 and 3, paragraph 3) Applicants submit that the specification provides adequate written description of the invention. The rulebook and rule page are described on pages 7-8 in the Specification.

A rule book controls moving content into and out of a database in a content provider (Specification, page 6, lines 18-22). A rule page corresponds to a user profile (Specification, page 7, lines 17-21). A rule page may also be maintained by the target computer regarding the profiles of the content providers (Specification, page 10, lines 9-16). On the other hand, a cookie is simply an HTTP header that consists of a text only string that enters into the memory of a browser. The string contains the domain, path, lifetime, and value of a variable that a website sets. Here, the content provider may transmit an agent to the target computer and is not specific to the browser being used by the target computer (Specification, page 10, lines 22-26).

Regarding the triggering program, the triggering program may be part of the agent or the content provider. One task of the triggering program is to determine the significance of the information collected by the agent (Specification, page 11, lines 1-8).

In one embodiment, the rules are used by the rule book to select content delivered to the target computer (Specification, page 12, lines 3-5). A rule page contains information pertaining to the target computer or user (Specification, page 8, lines 1-2). The distinction between a rule page, a rule book, and rules is well explained throughout in the Specification. If necessary, the Examiner is urged to contact Applicants' representative for further clarification.

I. CLAIM OBJECTIONS

The Examiner objected to claim 43 because of informalities. Applicants have amended claim 43 accordingly.

Therefore, it is requested that the objection be withdrawn.

II. REJECTION UNDER 35 U.S.C. § 101

The Examiner rejected claims 14, 16-20, 23, 27, 32, 40, 42 and 45 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter for failing to recite a practical application within the technological arts. The Examiner contends that claims 1 and 7 would deemed statutory since they actually carry out a transmission of data where are claim 14 is not because it still recites a future transmission. Applicants respectfully disagree and traverse the rejection for the following reasons.

Applicants do not see how the Examiner came up with conclusion that claim 14 merely recites a future transmission of data. The Examiner must expressly state how the language of the claims has been interpreted to support the rejection (MPEP § 2106). The phrase "to be transmitted" does not connote a future event. Even if it does, this has nothing to do with the issue of the patentable subject matter under 35 U.S.C. § 101.

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine, it defines a statutory product. See, e.g., Lowry, 32 F.3d at 1583, 32 USPQ 2d at 1034-35, Warmerdam, 33 F3d. at 1361-62, 31 USPQ 2d at 1760. Here, claim 14 recites a content provider having the physical structure of a rule page and a rule book, to perform a useful task. This is within the framework of statutory subject matter under 35 U.S.C. § 101.

Therefore, the rejection under 35 U.S.C. § 101 is improper. Applicants respectfully request that the rejection be withdrawn.

## II. REJECTION UNDER 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims 1-14 and 16-45 under 35 U.S.C. §112, first paragraph. The Examiner stated that it is not clear how one of ordinary skill in the art could make, without undue experimentation, the claimed invention such that the rule book itself generates a rule based on the user rule page. The Examiner further stated that the original specification provides no support for "the rule controlling a direction of the content from the database." Applicants respectfully disagree and traverse the rejection for the following reasons.

The specification discloses, on page 9 (lines 1-2), the rule book generates rules specific to the target user. The specification, on page 12 (lines 13-19) discloses how to generate rules (e.g., in form of Scripts or an interpreted language script). The specification further discloses the content directed into and out of database is controlled by rules in the rule book (p. 6, lines 21-22).

The Examiner rejected claims 1-14 and 16-45 under 35 U.S.C. §112, second paragraph. The Examiner stated that it is unclear what it meant by "the rule controlling a direction of the content from a database to be transmitted." In response, Applicants would like to direct the Examiner to lines 21-22 of page 6 in the specification which states "the content directed into and out of database is controlled by rules in a rule book." A person skilled in the art should be able

to use create a program which use rule in a rule book to control the transfer of content in and out of a database.

Therefore, Applicants respectfully request the rejection under 35 U.S.C. § 112 be withdrawn.

III. REJECTION UNDER 35 U.S.C. § 103(A)

The Examiner rejected claims 1-14, 16-21, 27-30 and 36-45 under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 5,796,952 issued to Davis et al., (Davis) in view of U.S. Patent No. 5,423,043 issued to Fitzpatrick et al. (Fitzpatrick).

In particular, the Examiner stated that the added limitation has been interpreted as a database which generates various rules corresponding to different condition. Applicants note that this limitation was not added to independent claims 1, 7, and 14 in the response dated August 2, 2000.

As previously argued, Davis and Fitzpatrick, either taken alone or in combination, do not disclose a rulebook that generates a rule based on a user rule page.

Therefore, Applicants respectfully request the rejection under 35 U.S.C. 103 be withdrawn.

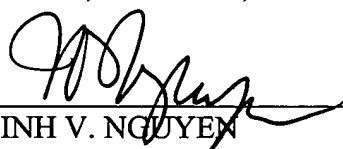
CONCLUSION

In view of the amendments and remarks made above, it is respectfully submitted that pending claims 1-4, 6-14, 16-38, and 41-45 are in condition for allowance, and such action is respectfully solicited.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

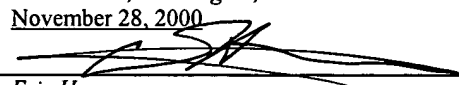
Dated: November 28, 2000

  
\_\_\_\_\_  
THINH V. NGUYEN  
Reg. No. 42,034

12400 Wilshire Boulevard, Seventh Floor  
Los Angeles, California 90025  
(714) 557-3800

CERTIFICATE OF MAILING

*I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on:*  
November 28, 2000

  
\_\_\_\_\_  
Eric Hoover

11/28/00  
\_\_\_\_\_  
Date